



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

08/981,461 12/23/97 FELDBAU

0 75483

EXAMINER

LM02/0803

CODDINGTON, T

ART UNIT

PAPER NUMBER

LEYDIG VOIT & MAYER
TWO PRUDENTIAL PLAZA
SUITE 4900
180 NORTH STETSON
CHICAGO IL 60601-6780

2767

DATE MAILED:

08/03/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/981,461

Applicant(s)
Feldbau et al.

Examiner
Trevor Coddington

Group Art Unit
2767



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-161 is/are pending in the application.

Of the above, claim(s) 1-63 is/are withdrawn from consideration **TC**

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 64-66, 68, 69, 71-80, 92-98, 100, 101, 103-111, 123-127, 131-134, 137-140, 144, 145, 147, 149-151, 153-155, 158-161 are rejected. **TC**

☒ Claim(s) 67, 70, 81-91, 99, 102, 112-122, 128-130, 135, 136, 141-143, 146, 148, 152, 156, 157 are objected to. **TC**

☐ Claims _____ are subject to restriction or election requirement. **TC**

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2767

DETAILED ACTION

1. Claims 1-63 have been cancelled as requested in the Applicants' preliminary amendment.
2. Claims 64-161 have been added and examined.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

4. The term "at least part of" in claim 75 is a relative term which renders the claim indefinite. The term "at least part of" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear to the Examiner what defines or comprises parts of a dispatcher, therefore claiming the apparatus to comprise at least part of the dispatcher renders the claim indefinite.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 2767

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

6. Claims 64-66, 69, 71-79, 92-96, 98, 100, 101, 103-110, 123-127, 131, 132, 134, 137-140, 144, 145, 149-151, 153, 154 and 160 are rejected under 35 U.S.C. 102(b,e) as being anticipated by Bouricius et al. (U.S. Patent 4,326,098).

Claims 64 and 75

Bouricius et al. disclose a system, based on the concept of a vault or central authority, for authenticating that certain information has been transmitted from a sender via a dispatcher (e.g. vault) to a recipient. Bouricius et al. disclose a means for providing a set A comprising information on the contents of the information being electronically transmitted, a time indication associated with said dispatch and information describing the destination of said dispatch. (col. 9: 13-30) Bouricius et al. disclose encrypting and step-coding the information to resist or indicate tampering by either the sender or receiver. (col. 9: 31-46) Bouricius et al. disclose associating and securing the dispatch-related information with the contents by generating authorization-information. (col. 9: 24-26 and 31-46, where the authorization information is the original ciphertext from the sender to be later used for arbitration if a dispute arises.)

Claim 65

Bouricius et al. disclose associating the time of the dispatch. (col. 9: 24-26)

Art Unit: 2767

Claim 66

Bouricius et al. disclose dispatch-related information comprising an indication of identification associated with the sender and recipient. (col. 9: 15-16)

Claims 69, 71 and 72

Bouricius et al. disclose the contents are provided from the sender by electronic means over a communication network using a terminal. (abstract)

Claims 73, 77 and 78

Bouricius et al. disclose authenticating the identity of the sender and/or recipient. (col. 9: 22-24 and 53-55)

Claim 74

Bouricius et al. do not explicitly disclose a means for providing the dispatched information to the dispatcher for electronic transmission to said recipient. However, this feature is inherent because the vault in the Bouricius et al. system acts as the dispatcher and all dispatch information and authentication information is transmitted to all concerned parties.

Claim 76

Bouricius et al. disclose the vault generating the time of dispatch. (col. 9: 24-26)

Claim 79

Bouricius et al. disclose providing an output of the authentication-information in electronic form. (col. 9:31-46)

Art Unit: 2767

Claim 92

Bouricius et al. disclose encrypting the message with the sender's key for later authentication purposes. (col. 9: 13-20)

Claim 93

Bouricius et al. disclose using a register containing the names of all authorized users of the vault. (abstract)

Claims 94-96, 98, 100, 101, 103-109, 123

The Applicants' claimed method is the methodology used in the Applicants' claimed apparatus. Therefore, claims 94-96, 98, 100, 101, 103-109 and 123 are rejected as applied to claims 64-66, 69, 71-74 and 76-79.

Claim 110

Bouricius et al. disclose providing an output to the sender, recipient and arbitrator. (col. 10: 17-20)

Claim 124

Bouricius et al. disclose using an authenticator associated with a party other than the sender. (col. 10: 17-24)

Claim 125

Bouricius et al. disclose a method for authenticating a dispatch and contents of the dispatch comprising: receiving content data representative of the contents of the dispatch and a destination of the dispatch (col. 9: 31-67 and col. 10: 17-24, where ciphertexts, C1 and C2, are used for

Art Unit: 2767

authentication); providing a secure indicia relating to a time of transmission of the dispatch (col. 9: 22-26 and 60-67); and associating the secure content data with the secure dispatch record data (col. 9: 24-30 and col. 10: 1-5 where the ciphered content, C1 and C2, are associated with a step-cipher, ST1 and ST2).

Claims 126, 127, and 134

The limitations are identical in scope to those found in respective dependent claims 74, 79 and 92. Therefore, claims 126, 127 and 134 are rejected as applied to claims 74, 79 and 92.

Claim 131

Bouricius et al. disclose the time related indicia source being located at the vault, sender and receiver locations. (col. 9: 13-46, where the correspondents' clocks are external to the vault)

Claim 132

Bouricius et al. disclose the vault generates the time related indicia. (col. 9: 24-26)

Claims 137-140, 144 and 145

The Applicants' claimed authenticator performs the Applicants' claimed method for authenticating. Therefore, claims 137-140, 144 and 145 are rejected as applied to claims 125-127, 131, 132 and 134.

Claims 149-151, 153 and 154

The limitations in the Applicants' claimed information dispatch system are a combination of the limitations in previous claims. Therefore, claims 149-151, 153 and 154 are rejected as applied to claims 64, 79, 92, 94, 131, 132 and 137.

Art Unit: 2767

Claims 160

Bouricius et al. disclose providing a representation of either of said information elements. (col. 10: 20-25, where information elements are contained with ciphertexts, C1 and C2) Bouricius et al. disclose verifying by match the two ciphertexts which contain content data, addresses of sender and receiver, and the time of dispatch. (col. 9: 13-65)

7. Claim 159 is rejected under 35 U.S.C. 102(b) as being anticipated by Schneier, Applied Cryptography, 1st edition. Schneier explains a public-key certificate. (page 426, where the content of the dispatch is the public-key) The public key certificate comprises content data (public key), dispatch record data including time indicia (issue date) and the destination (user). The certificate is secured and authenticated through the digital signature applied by the issuing authority (dispatcher).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 68, 80, 97, 111, 133, 147, 155, 158 and 161 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouricius et al. (U.S. Patent 4,326,098) as applied to claims 64, 94, 125, 137, 149 and 160 above.

Art Unit: 2767

Claims 68 and 97

Bouricius et al. disclose authentication-information having an electronic form. Bouricius et al. do not disclose each element within the authentication-information can have a different form selected from the group consisting of the following forms: a paper document, microfiche and electronic information. Official notice is taken that paper documents and microfiche are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to modify the Bouricius et al. system to use paper documents or microfiche for the convenience of the user.

Claims 80, 111, 133, 147 and 155

Bouricius et al. do not disclose storing the authentication-information in the vault. Bouricius et al. do disclose storing the authentication-information in storage outside the vault. (Figure 2, col. 11: 43-51) It would have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to combine the storage elements and the vault into one apparatus in the Bouricius system for the advantage of having all authentication and storage operations occur at one location.

Claim 158

Bouricius et al. do not disclose generating a paper document printout of said electronic content data to be dispatched to said recipient via a selected manual delivery service. Official notice is taken that paper printouts and manual delivery services are old and well known in the art. As applied to claim 94, it would have been obvious to one of ordinary skill in the art at the time of the

Art Unit: 2767

Applicants' invention to modify the Bouricius et al. system to include a paper printout of the content data and the subsequent manual delivery for the advantage of allowing the recipient to visually verify the received message.

Claim 161

Bouricius et al. do not disclose using a verifiable digital signature scheme. Official notice is taken that verifiable digital signature schemes are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to modify the Bouricius et al. system to use a verifiable digital signature scheme for the advantage of creating a secure representation of the content that can be later verified for authenticity.

Allowable Subject Matter

10. Claims 67, 70, 81-91, 99, 102, 112-122, 128-130, 135, 136, 141-143, 146, 148, 152, 156, 157 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. Mueller-Schloer (U.S. Patent 4,458,109) discloses a security station service for providing registered mail features in an electronic communication system. Bisbee et al. (U.S. Patent 5,748,738)

Art Unit: 2767

disclose a system for electronic transmission, storage and retrieval of authenticated documents. Fischer (U.S. Patents 5,001,752 and 5,136,643) discloses a public/key date-time notary facility. Graziano et al. (U.S. Patent 5,163,091) disclose a knowledge based system for document authorization. Blandford (U.S. Patent 5,189,700) discloses devices to supply authenticated time-stamps for authenticating digital documents. Fischer (U.S. Patent 5,422,953) discloses a personal date/time notary device. Cordery et al. (U.S. Patent 5,454,038) disclose an electronic data interchange postage evidencing system that incorporates time-stamps and authentication of data. Barbará et al. (U.S. Patent 5,475,753) disclose an apparatus for certifying the delivery of information. Wolff et al. (U.S. Patent 5,671,282) disclose a method and apparatus for document verification and tracking. Zunquan (U.S. Patent 5,771,292) disclose a device for data integrity and authentication. Huber et al. (U.S. Patent 5,781,630) disclose a device for accurately dating an electronic document. Dove (U.S. Patent 5,910,986) discloses an apparatus for sending electronic data signals including a time-stamp and authentication data. Walker et al. (U.S. Patent 5,923,763) disclose a method and apparatus for secure document time-stamping. A website located at www.ccvault.com and operated by the company of the same name certifies and registers an authorized user's email. CNET News.com article, "Firm offers certified email."

12. Any inquiry concerning this communication from the Examiner should be directed to Trevor Coddington whose telephone number is (703) 305-4458. The Examiner can normally be reached Monday-Thursday from 7:30 A.M. to 6:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tod Swann, can be reached at (703) 308-7791.

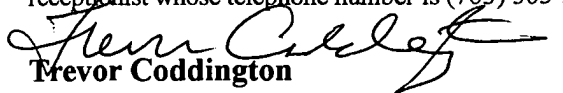
Application/Control Number: 08/981,461

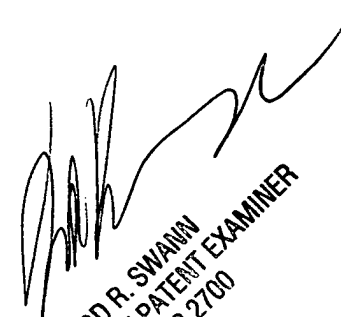
Page 11

Art Unit: 2767

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Trevor Coddington
Patent Examiner, Art Group #2767
E-mail: trevor.coddington@uspto.gov
July 28, 1999


TOD R. SWANN
SUPERVISORY PATENT EXAMINER
GROUP 2700